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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/795,997	02/05/1997	CHRISTOPHER J. MONAHAN	TU990007XR	8433

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ROBERT M SULLIVAN  
IBM CORPORATION  
INTELLECTUAL PROPERTY LAW  
9000 S RITA ROAD  
TUCSON, AZ 85744

EXAMINER

CHOULES, JACK M

ART UNIT PAPER NUMBER

2167

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

08/795,997

**Applicant(s)**

MONAHAN ET AL.

**Examiner**

Jack M Choules

**Art Unit**

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on through 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

1. Claims 1-9 are presented for examination. Claims 1-4 are as were present in the parent patent. And Claims 5-9 have been added by amendment in the reissue application.

### *Response to Arguments*

2. Applicant's arguments filed 16 June 2004 have been fully considered but they are not persuasive. As to the rejection of claims 5-9 under 35 U.S.C. 251 as being improper recapture.

The applicant argued as follows:

"In contrast to the position expressed in the Office Action **adding a limitation to a claim does not in and of itself support improper recapture**. See, e.g., *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (FH. Cir. 1993). Rather, to determine whether an applicant's surrendered particular subject matter one should look to the prosecution History for arguments and changes to the claims *made in an effort to overcome a prior art rejection*. See *Mentor* at 998 F.2d at 995-96, 27 USPQM at 1524, 25. Moreover, if the argument that the claim limitation defined over the rejection if made, *must be specific as to the limitation*; rather than a general statement regarding the claim as a whole. See MPEP 1412.02. Nowhere does the Office Action provide any support that the purported amendment to claims 1 and 6 was made in an effort to overcome a prior art rejection, and that the arguments to such amendment were specific as to the limitation as required by the authorities cited above. Rather, as provided in the reissue oath/declaration, the insertion of the controller within the automated storage library was described as error. As such, **claims 5-9 do not represent an improper recapture.**" (Bold added)

*Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1524 (FH. Cir. 1993).

Coloplast argues that claims 6-9 of the reissue patent are invalid because they are not based on "error" within the meaning of 35 U.S.C. Section 251 (1988). Coloplast argues that Mentor deliberately and intentionally amended its claims in response to a prior art rejection and that such conduct is not reissuable error. Thus, it asserts, the court erred as a matter of law. We agree.

[1] Whether the statutory requirement of "error" has been met is an issue of law which we review de novo. This legal conclusion is based on underlying factual inquiries which are reviewed for substantial evidence. See *Ball Corp. v. United States*, 729 F.2d 1429, 1439, 221 USPQ 289, 297 (Fed. Cir. 1984) ("On the basis of the facts before us and the reasons given for the cancellation of the claims from the original application, we cannot find, as a matter of law, that [the patentee] is barred from securing reissue....").

Art Unit: 2167

Section 251 provides in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

Reissue "error" is generally liberally construed, and we have recognized that " [a]n attorney's failure to appreciate the full scope of the invention" is not an uncommon defect in claiming an invention. *In re Wilder*, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1209 (1985).

**However, the reissue procedure does not give the patentee "a second opportunity to prosecute *de novo* his original application,"** *In re Weiler*, 790 F.2d 1576, 1582, 229 USPQ 673, 677 (Fed. Cir. 1986).

The deliberate cancellation of a claim of an original application in order to secure a patent cannot ordinarily be said to be an "error" and will in most cases prevent the applicant from obtaining the cancelled claim by reissue. The extent to which it may also prevent him from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.

*In re Willingham*, 282 F.2d 353, 357, 127 USPQ 211, 215 (CCPA 1960).

**If a patentee tries to recapture what he or she previously surrendered in order to obtain allowance of original patent claims, that "deliberate withdrawal or amendment... cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. Section 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the matter withdrawn."**

*Haliczer v. United States*, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966). "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were cancelled from the original application." *Ball Corp.*, 729 F.2d at 1436, 221 USPQ at 295 (citations omitted). **The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable**, *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984), but that is not the situation here. (Bold added)

Art Unit: 2167

The examiner responds that yes the record of the parent must show the amendment and/or arguments where to overcome the prior art. MPEP 1412.02 lays forth the minimal acceptable evidence that a limitation in the parent patent was surrendered under improper recapture: First Argument alone in MPEP 1412.02:

## 2. Examples of the Pannu Second Step Analysis:

### (A) Example (1) - Argument without amendment:

In *Hester*, supra, the Federal Circuit held that the surrender which forms the basis for impermissible recapture "can occur through arguments alone". 142 F.3d at 1482, 46 USPQ2d at 1649. For example, assume that limitation A of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. If the omitted limitation A was argued in the original application to make the application claims allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application, and recapture will exist. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution history of the original patent file for recapture, even where the claims were never amended during the prosecution of the application which resulted in the patent.

Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation relied upon, rather than a general statement regarding the claims as a whole. A general 'boiler plate' sentence in the original application will not, by itself, be sufficient to establish surrender and recapture.

An example of a general "boiler plate" sentence of argument is:

"In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable." An argument that merely states that all the limitations of the claims define over the prior art will also not, by itself, be sufficient to establish surrender and recapture.

The statement that "if the argument that the claim limitation defined over the rejection if made, *must be specific as to the limitation*; rather than a general statement regarding the claim as a whole." Is expressed when arguments are used alone to establish surrender of subject matter.

Thus in the present case were amendment is used this does not relevant.

Amendment alone MPEP 1412.02:

### (B) Example (2) - Amendment of the claims without argument:

The limitation omitted in the reissue claim(s) was added in the original application claims for the purpose of making the application claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the

Art Unit: 2167

record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter. Accordingly, the reissued claims would be barred by the recapture doctrine.

Mentor Corp. v. Coloplast, Inc shows that evidence from arguments can be used to strengthen evidence from the amendment through there example in examining the evidence of the particular prosecution history for the claims under review tin that review.

3. In the claims presently under consideration the examiner referred to the 05 April 1993 amendment to the parent application, the applicant added to claims 1 and 6 (renumbered as claim 3 in patent 5,388,260 which was issued from the prosecution), in the amendment the attached comments stated that the examiner had a standing art rejection under 35 U.S.C. 103 as unpatentable over Gallo et al in view of Sills et al. (see page 8 last full paragraph of said amendment). Although the comments referred to some elements, which were, corrected for clarification of the claim language but the incorporation of the "controller" within the "automated storage library" was not included as a simple language clarification (see page 7 first full paragraph and paragraph starting on page 7 and ending on page 8 of said amendment) Further after the entry of said amendment and comments the examiner allowed the application without further comments. Further, in the comments of the amendment there is a brief explanation of the amendment the claimed elements under question where included as the

Art Unit: 2167

“controller” was discussed as “in the library” (page 6, beginning of paragraph halfway down the page). And finally in the arguments presented against the rejection of claims 1 and 6 applicant states “Gallo et al **do not disclose a library capable of determining the location of a volume therein**. The language cited by the Examiner in Gallo et al indicates that **the location of the volume is stored in a catalog which is not part of an automated storage library**, or even the same peripheral storage drive in which the volume itself is located. The brief mention in Gallo et al of a library is for the storage of the volumes (i.e. optical disk drive 15 is in the library), not for the storage of the catalog (i.e. **catalog 14 is not in the library**). In addition, the features previously discussed with respect to the rejections under 35 U.S.C. 112 (for example, the transparency of the devices **in the library to the host processor, as supported by the operations of the controller**) are not disclosed by Gallo et al.” (Bold added). In the prior art the catalog stores the location of the volumes, in the claims the location is stored in the controller. The applicant makes a point that the catalog in the prior art is not in library this only distinguishes over the language of the claims if the controller is in the library. Thus the arguments support the conclusion that the amendment of the claims placing the controller in the automated storage library was purposeful to clearly overcome the art of record.

4. Further the record shows after the examiners final rejection containing the above mentioned art rejection of claims 1 and 6 an interview was helped on 21 January 1993 where “language changes and additional limitations” were discussed although specific changes were not mentioned it clearly follows that the amendment filed 29 January 1993 was a direct result of the discussion with the examiner, and an advisory action mailed 12 February 1993 refused to enter the amendment because the independent claims (claim 1 and 6) were amended to recite

Art Unit: 2167

features not previously claimed thus requiring further consideration and /or search. A continuation was filed to reopen prosecution and enter a preliminary amendment being the same amendment as that refused entry after final and was filed 5 March 1993. Thus a concerted effort was made to get the claims to read over the art of record and in condition for allowance.

5. After the review outlined above the examiner concludes that the rejection although originally not showing the evidence that the amendment was to overcome the art of record, the rejections under 35 U.S.C. 251 as being an improper recapture is a proper rejection as the record has sufficient evidence that the amendment was purposely made to overcome the art of record to make and maintain the rejection as restated below.

#### ***Reissue Applications***

**Claim 9 is rejected under 35 U.S.C. 251 as being an improper recapture of** broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.



In the 05 April 1993 amendment to the parent application, the applicant added to claims 1 and 6 (renumbered as claim 3 in patent 5,388,260 which was issued from the prosecution) the limitation “removable data storage media”. Claim 9 omits the limitation “removable.” This omitted limitation broadens the scope of the patent claim 3 in such a way that subject matter that was surrendered during the prosecution of the parent application is recaptured.

**Claims 5-9 are rejected under 35 U.S.C. 251 as being an improper recapture of** broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the 05 April 1993 amendment to the parent application, the applicant added to claims 1 and 6 (renumbered as claim 3 in patent 5,388,260 which was issued from the prosecution) the limitation “and a controller coupled ...” in such a way that the “controller” was listed as included **within** (included in the list of elements making up) an “automated storage library” (see also discussion of errors on page 5 and 6 of the reissue oath/declaration where the insertion of

the “controller” **within** the “automated storage library” was described as an error. Note it may be an error but is an improper error for reissue correction as this limitation was surrendered through amendment during prosecution of the parent, the declaration is still considered valid as at least one valid error remains disclosed).

Claims 5-9 of the current application have the limitations to the “controller” but are worded in such a way that the controller is not specified to be **within** the “library” this is a broadening of the claims in respect to this particular element as the controller may with the new wording not only be **within** but also may be “**without**” increasing the possibilities for implementation of the controller element in independent claims 5,7, and 9 thus claims 5-9 are broader in respect to this asset and no other limitation would limit the controller to be within the library.

This broadened element was surrendered in the parent application because the controller was placed within the “automated storage library” of the independent claims 3 and 6 present in the parent application by the above-mentioned amendment. Although functions that are preformed by the “controller” were recited in the before that amendment the fact the functions were preformed in the “controller” and **within** the “automated storage library.” Thus the amendment detailed above surrendered the limitation under discussion and the omission of the limitation results in improper recapture.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

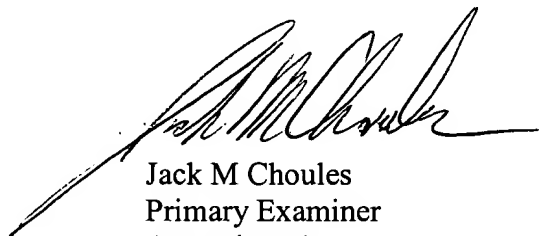
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2167

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules  
Primary Examiner  
Art Unit 2167

31 March 2005